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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,643

04/09/2004

Robert J. Medoff

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9009

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EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

12/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,643	Applicant(s) MEDOFF, ROBERT J.	
	Examiner JAMES L. SWIGER III	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 and 54-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-37 and 54-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-45 and 58-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/9/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 58 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 58 recites the limitation "the pin" in line 3. There is insufficient antecedent basis for this limitation in the claim. Applicant has positively claimed "the pin," however pin is only mentioned in the preamble of the claim and is not positively claimed structure. Appropriate action is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

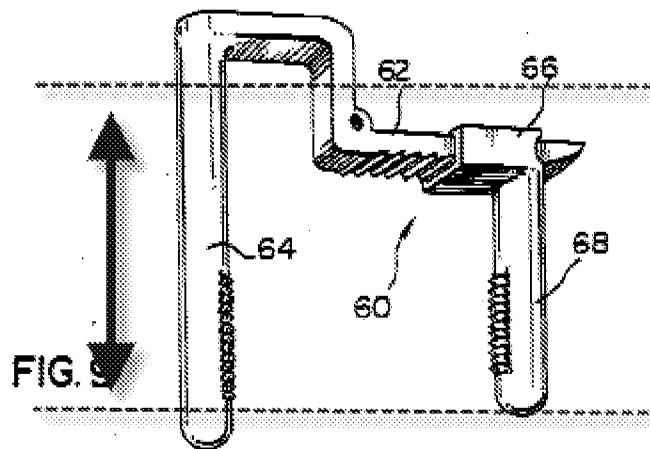
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-39, 41-45, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Medoff (US Patent 5,709,682) in view of Outerbridge (US Patent 4,852,558). Medoff discloses a surgical pin comprising a single wire having a U-shaped bend (2/3, Fig. 6) defining a first region, with opposite legs extending from the U-shaped bend, wherein said legs have distal ends (5) that are bent away and are capable of buttressing a surface of a bone (see Fig. 7). The legs are considered parallel to one another and the legs are of equal length. Medoff also discloses a pin in combination

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with a washer (6, Fig. 6) which can assist in holding the pin legs in relation to another, or alternatively, assist in holding or securing the pin to a bone (with an alternative pin 4).

Medoff discloses the claimed invention except for a region extending from the U-shaped bend which is a second region in proximity to the distal end, in which the spacing of the legs is different, or wherein the length of the legs in the distal region is unequal. Outerbridge discloses a fixation device that has two legs extending from a U-shaped bend region that have the legs separated at a first and second distance and also wherein the legs are of different lengths (i.e. unequal). See also Fig. 13i. See annotated drawing below. The top line shows a beginning of a leg region from the bend and the bottom line shows the difference in leg lengths.



It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Medoff having at least a region extending from the U-shaped bend which is a second region in proximity to the distal end, in which the spacing of the legs is different, or wherein the length of the legs in the distal region is unequal as taught by Outerbridge so that the fixation device has a better fit in relation

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to varying patient and bone anatomies. A customized design and size helps the fixation device to fit better.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Medoff and Outerbridge as applied to claim 39 above, and further in view of Gasper (US Patent 1,315,926). The combination of Medoff and Outerbridge disclose the claimed invention except for at least one of the legs is bent outwardly in a direction away from the other leg. Gasper shows a single wire fixation device that utilizes a bend in a direction away from another (at least a portion of) leg at a region (4). This region defines a shoulder which helps to rest against the area to be fixed, and helps to prevent undue movement. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the combination of Medoff and Outerbridge having at least a region extending outwardly in view of Gasper to enable better fixation relative to varying patient/bone geometry.

Response to Arguments

Applicant's arguments submitted 3/24/2008 and 8/11/2008 have been fully considered but are moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is

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(571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/
Examiner, Art Unit 3775
/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733